

**REMARKS**

Claims 1-18 are pending in the application. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

***35 U.S.C. § 103 Rejection***

Claims 1-18 were rejected under 35 U.S.C. §103(a) over US Patent Application Publication No. 2002/0040334 to YAMAZAKI in view of US Patent No. 6,338,043 to MILLER. This rejection is respectfully traversed.

The Examiner acknowledges that YAMAZAKI fails to disclose, among other things, the recited baseline price step. However, the Examiner explains that such features are taught by MILLER and that it would have been obvious to combine the teachings of these documents. Applicants respectfully submit that a *prima facie* case of obviousness has not been established as the applied references fail to teach each and every element of the claims.

Independent claim 1 recites, *inter alia*,

for each unit of a plurality of units of data processing services, determining a level of environmental complexity, a level of change, and a type of environment; and for each unit of the plurality of units, assigning points to the unit responsive to its level of environmental complexity, level of change, and type of environment, as determined, and summing the assigned points to provide a count of points for the unit.

Additionally, independent claim 8 recites, *inter alia*,

for each unit of a plurality of units of data processing services, selecting a level of environmental complexity from a plurality of predetermined levels of environmental complexity, selecting a level of change from a plurality of predetermined levels of change, and selecting a type of environment from a plurality of predetermined types of environments; and for each unit of the plurality of units, assigning points to the unit responsive to its selected level of environmental complexity, level of change, and type of environment, and summing the assigned points to provide a count of points for the unit.

Finally, independent claim 10 recites, *inter alia*,

determining a level of environmental complexity, a level of change, and a type of environment for a unit to be added to the data processing services; and determining a count of points for the unit to be added, using the level of environmental complexity, level of change, and type of environment.

While the Examiner apparently believes that the above-noted features are recited in YAMAZAKI, the Examiner has failed to identify any language whatsoever in YAMAZAKI which even remote discusses or discloses for each unit of a plurality of units of data processing services, determining a level of environmental complexity, a level of change, and a type of environment, much less, that for each unit of the plurality of units, assigning points to the unit responsive to its level of environmental complexity, level of change, and type of environment, as determined, and summing the assigned points to provide a count of points for the unit (claim 1).

Nor can the Examiner do so because YAMAZAKI merely relates to a method and device for setting a support service fee by taking account of how much a user uses the support services. While it is true that the disclosed system can be used to price data processing services (see paragraph [0002]), YAMAZAKI is entirely silent with regard to determining a level of environmental complexity, a level of change, and a type of environment.

As such, YAMAZAKI also fails to disclose or suggest that for each unit of a plurality of units of data processing services, selecting a level of environmental complexity from a plurality of predetermined levels of environmental complexity, selecting a level of change from a plurality of predetermined levels of change, and selecting a type of environment from a plurality of predetermined types of environments, much less, that for each unit of the plurality of units, assigning points to the unit responsive to its selected level of environmental complexity, level of change, and type of environment, and summing the assigned points to provide a count of points

for the unit (claim 8) and/or determining a level of environmental complexity, a level of change, and a type of environment for a unit to be added to the data processing services, much less, determining a count of points for the unit to be added, using the level of environmental complexity, level of change, and type of environment (claim 10).

MILLER does not cure the deficiencies of YAMAZAKI. MILLER relates to a system for developing packages of advertising spots. The disclosed system is entirely different from that of YAMAZAKI and the instant invention. Accordingly, there is no basis for modifying the teachings of YAMAZAKI.

Furthermore, even if one could reasonably argue that MILLER is properly combinable with YAMAZAKI, MILLER, like YAMAZAKI, is entirely silent with regard to determining a level of environmental complexity, a level of change, and a type of environment (claim 1). As such, YAMAZAKI also fails to disclose or suggest that for each unit of a plurality of units of data processing services, selecting a level of environmental complexity from a plurality of predetermined levels of environmental complexity, selecting a level of change from a plurality of predetermined levels of change, and selecting a type of environment from a plurality of predetermined types of environments, much less, that for each unit of the plurality of units, assigning points to the unit responsive to its selected level of environmental complexity, level of change, and type of environment, and summing the assigned points to provide a count of points for the unit (claim 8) and/or determining a level of environmental complexity, a level of change, and a type of environment for a unit to be added to the data processing services, much less, determining a count of points for the unit to be added, using the level of environmental complexity, level of change, and type of environment (claim 10).

Although the Examiner has concluded that it would have been obvious to combine the teachings of YAMAZAKI and MILLER, the Examiner neglects to set forth any proper basis for combining the teachings of the applied documents. In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason *why* one of ordinary skill in the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972 (B.P.A.I. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). As noted above, each of the applied documents is silent with regard to a number of recited features and each of the documents relates to different devices that function in different manners. Moreover, MILLER does not teach or suggest modifying the structure or operation of YAMAZAKI in the manner asserted by the Examiner.

Because the art of record fails to provide any reasonable explanation why one ordinarily skilled in the art would utilize such an arrangement, and/or fails to disclose or suggest the problems that such an arrangement would address, Applicant submits that the art of record fails to provide the requisite motivation or rationale as to *why* one ordinarily skilled in the art would modify YAMAZAKI to include features of any of the secondary references in the manner asserted by the Examiner. That is, Applicant submits that because the Examiner has not set forth any basis or reason found in the art of record for combining these documents, the instant

rejection has no basis in the art of record, such that the rejection is improper and should be withdrawn.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). As stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984):

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Applicant submits that the only reason to combine the teachings of the applied references in the manner proposed by the Examiner is the result of a review of Applicant's disclosure and the application of impermissible hindsight. And, in any event, such a combination would still not result in the claimed invention.

Furthermore, to the extent that the Examiner is basing the instant rejection on an argument of inherency consistent with MPEP 2112, Applicant notes that MPEP 2112 specifically states, in part:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter

balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Additionally, to the extent that the Examiner relies upon official notice in support of the instant rejection, Applicant reminds the Examiner that MPEP 2144.03 specifically explains that "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." Applicant submits that the facts asserted by the Examiner, in view of the claimed invention, are not well known. The Examiner has also failed to provide any such documentary evidence. Accordingly, Applicant respectfully requests that the Examiner produce documentary evidence to support the Examiner's assertions to the extent that the Examiner is relying on official notice.

Accordingly, Applicant submits that no proper combination of YAMAZAKI and MILLER discloses or suggests the combination of features recited in at least claims 1, 8 and 10. Moreover, in addition to failing to disclose the combination of features recited in the above-noted claims 1, 8 and 10, Applicant submits no proper combination of these documents discloses

or suggests the combination of features recited in dependent claims 2-7, 9 and 11-18, which also respectfully contain all of the features of claims 1, 8 and 10.

Accordingly, Applicants respectfully submit that the above-noted rejection under 35 U.S.C. § 103(a) should be withdrawn.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Any fees required for consideration of the instant response are hereby authorized to be charged to our Deposit Account No. 09-0457.

Respectfully submitted,  
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